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MICHAEL CHAN NCR CORPORATION 1700 SOUTH PATTERSON BLVD DAYTON, OH 45479-0001			EXAMINER MONFELDT, SARAH M	
			ART UNIT 3692	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/891,920

Applicant(s)

NICOLL ET AL.

Examiner

SARAH M. MONFELDT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No./Mail Date: _____

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DETAILED ACTION
Status of Claims

1. This action is in reply to the Amendment filed on 28 February 2008.
2. Claims 1, 3, 6, 11, 12, and 14 were amended.
3. Claims 1-14 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6-8, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Lynch et al (hereinafter Lynch, US 6,029,971) and further in view of Sevak et al. (US 3961784)

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Re Claim 1: Graef discloses a self-service terminal comprising:

- A plurality of separate media modules (see at least Fig 1, 44, 46, 48, 50; Column 7, lines 42-52)), each module operatively associated with a separate pick mechanism for picking media from the module (see at least Fig 1, 34, 36, 38, 40; Column 7, lines 26-41) and transferring the picked media to a media dispense path (see at least Column 7, lines 53-62), at least one a second one of the media modules being associated with a separate friction pick mechanism (See at least Fig 2 and description Column 8 line 39-Column 10 line 50; cites friction portions of picking mechanism)

In addition, Graef notes that ATMs can be used to dispense a variety of different medias including cash, tickets, scrip, vouchers or other documents (see at least Column 1, lines 18-35). Furthermore, Graef discloses that the modules may hold a variety of different types of documents in the same machine (see at least Column 7, lines 46-48).

Graef does not explicitly disclose at least a first one of the media modules being associated with a vacuum pick mechanism. Graef however discloses at col. 13, l. 64 through col. 14, l. 7 that the Graef picking mechanism may be readily retrofit to an existing automated banking machine. Moreover, this allows for replacing an existing picking member which does not include the features of the Graef picking mechanism and install the Graef picking mechanism in the existing picking mechanism's place. Graef therefore, teaches two different types of picking mechanisms within one unit. Lynch discloses that sheet feeding apparatus, such as the one disclosed by Graef "are commonly of either the vacuum pick or friction pick type," and depending on the type of media involved cites the advantages and disadvantages for each (see at least Column 1, lines 5-20). Some media as Lynch points out is better served with a friction mechanism (medias that need a high feed rate), while other media would be better served with a vacuum mechanism (high porous). Moreover, Sevak et al. discloses "a document feeder of an apertured friction feed belt and an apertured feed pulley for pickably feeding documents from a hopper into a document guideway, a vacuum chamber being stationarily disposed within the feed to apply a low pressure vacuum to a linear section", please refer to col. 2, ll. 40-51 of Sevak et al. Thus, Sevak et al. discloses a vacuum pick and friction pick with in the same unit which provides a document feeder that will operate reliably and uniformly at speeds of from 300 to 600 inches per second, to thereby accommodate a reader sorter throughput rate of from 3000 to 5000 document per minute (see at least col. 2, ll. 23-28, 40-51).

Thus, it would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of Lynch and Sevak et al. to the disclosure of Graef so that an ATM containing multiple media types, can distribute the different types of media in the most efficient and practical way possible.

Re Claim 2: Graef in view of Lynch and further in view of Sevak et al. discloses the claimed terminal and Lynch further discloses wherein the modules are removable (see at least Column 2, lines 59-62). While not explicitly disclosing wherein the modules are also interchangeable, this step is notoriously well known in the art and would have been obvious to one of ordinary skill, so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

Re Claim 3: Graef in view of Lynch and further in view of Sevak et al. discloses the claimed terminal and Graef further discloses wherein the at least a second one of the module associated with the friction pick mechanism is a friction pick module and the friction pick mechanism is contained within the friction-picking module (See at least Fig 1, Column 7, lines 34-35).

Re Claim 6: Graef discloses a self-service terminal comprising:

- Means defining a media dispense path (see at least Fig 1, See arrows related to Refs 54, 56, 60 and 62)

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- (See at least Fig 1 Refs 34, 36, 38 and 40; See Fig 2 and description Column 8 line 39-Column 10 line 50; cites friction portions of picking mechanism)
- A plurality of separate media modules (see at least Fig 1, 44, 46, 48, 50; Column 7, lines 42-52), each media module operatively associated with a separate pick mechanism for picking media from the module (see at least Fig 1, 34, 36, 38, 40; Column 7, lines 26-41) and transferring picked media to the media dispense path (see at least Column 7, lines 53-62), at least a first one of the modules being associated with a separate vacuum pick mechanism and at least a second one of the media modules being associated with a separate friction pick mechanism (See at least Fig 2 and description Column 8 line 39-Column 10 line 50; cites friction portions of picking mechanism)

In addition, Graef notes that ATMs can be used to dispense a variety of different medias including cash, tickets, scrip, vouchers or other documents (see at least Column 1, lines 18-35). Furthermore, Graef discloses that the modules may hold a variety of different types of documents in the same machine (see at least Column 7, lines 46-48).

Graef does not explicitly disclose at least one module being associated with a vacuum pick mechanism. Graef however discloses at col. 13, l. 64 through col. 14, l. 7 that the Graef picking mechanism may be readily retrofit to an existing automated banking machine. Moreover, this allows for replacing an existing picking member which does not include the features of the Graef picking mechanism and install the Graef picking mechanism in the existing picking mechanism's place. Graef therefore, teaches two different types of picking mechanisms within one unit. Lynch discloses that sheet feeding apparatus, such as the one disclosed by Graef "are commonly of either the vacuum pick or friction pick type," and depending on the type of media involved cites the advantages and disadvantages for each (see at least Column 1, lines 5-20). Some media as Lynch points out is better served with a friction mechanism (medias that need a high feed rate), while other media would be better served with a vacuum mechanism (high porous). Moreover, Sevak et al. discloses "a document feeder of an apertured friction feed belt and an apertured feed pulley for pickably feeding documents from a hopper into a document guideway, a vacuum chamber being stationaryly disposed within the feed to apply a low pressure vacuum to a linear section", please refer to col. 2, ll. 40-51 of Sevak et al. Thus, Sevak et al. discloses a vacuum pick and friction pick with in the same unit which provides a document feeder that will operate reliably and uniformly at speeds of from 300 to 600 inches per second, to thereby accommodate a reader sorter throughput rate of from 3000 to 5000 document per minute (see at least col. 2, ll. 23-28, 40-51).

Thus, it would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of Lynch and Sevak et al. to the disclosure of Graef so that an ATM containing multiple media types, can distribute the different types of media in the most efficient and practical way possible.

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Re Claim 7: Graef in view of Lynch discloses the claimed terminal and Lynch further discloses wherein the media modules are removable (see at least Column 2, lines 59-62). While not explicitly disclosing wherein the modules are also interchangeable, this step is notoriously well known in the art and would have been obvious to one of ordinary skill, so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

Re Claim 8: Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction picking mechanism is contained within the media module associated with the friction-picking module (see at least Fig 1, Column 7, lines 34-35).

Re Claim 13: Graef discloses the claimed media-dispensing module but does not explicitly disclose means for enabling the media module to be removed and interchangeable. Lynch discloses a self service terminal wherein the modules are removable (see at least Column 2, lines 59-62). It would have been obvious to anyone of ordinary skill in the art at the time of invention to include the teachings of Lynch to the disclosure of Graef so that said modules can be taken from the machine to either be refilled or taken to a remote location for deposit or reconciliation with records related to transactions at the machine.

While the references do not explicitly disclose wherein the modules are also interchangeable, this step is notoriously well known in the art and would have been obvious to one of ordinary skill, so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

6. Claim 4-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Lynch et al (hereinafter Lynch, US 6,029,971) and further in view of Sevek et al., as applied to claims 1-3, 6-8, 13 above, and further in view of Drescher (US 6,131,809).

Re Claim 4: Graef in view of Lynch discloses the claimed terminal and Drescher further discloses wherein the friction pick module comprises a plurality of friction pick units, each unit including a media container and a friction pick mechanism (see at least Fig. 58; Column 28, lines 1-22). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the terminal of Graef in view of Lynch to include separate containers with associated friction pick mechanisms as taught by Drescher. One of ordinary skill in the art at the time of the invention would have been motivated to expand the terminal of Graef in view of Lynch in this way since removable canisters allows for easier removal by authorized personnel (see at least col. 11, ll. 40-46 of Drescher) and since the picking operations are executed concurrently and multiple bills may be picked from the various storage locations and moved as a stream of separated notes (see at least col. 29, ll. 61-67 of Drescher).

Re Claim 5: Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction pick units share a common media exit path within the module and leading to the

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media dispense path (See at least Fig 1, process 54 across common path 56 to secondary transport 60; Column 7 lines 53-67).

Re Claim 9: Graef in view of Lynch discloses the claimed terminal and Drescher further teaches wherein the media module associated with friction pick mechanism comprises a plurality of friction pick units, each unit including a media container and a friction pick mechanism (see at least Fig. 58; Column 28, lines 1-22). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the terminal of Graef in view of Lynch to include separate containers with associated friction pick mechanisms as taught by Drescher. One of ordinary skill in the art at the time of the invention would have been motivated to expand the terminal of Graef in view of Lynch in this way since since removable canisters allows for easier removal by authorized personnel (see at least col. 11, ll. 40-46 of Drescher).

Re Claim 10: Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction pick units share a common media exit path which is within the media module and leads to the media dispense path (see at least See Fig 1, process 54 across common path 56 to secondary transport 60; Column 7 lines 53-67).

7. Claim 11-12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Lynch et al (hereinafter Lynch, US 6,029,971) and Drescher (US 6,131,809).

Re Claim 11: Graef discloses a self-service terminal comprising:

- Means defining a media dispense path (see at least Fig 1, See arrows related to Refs 54, 56, 60 and 62)
- A plurality of separate and removable media modules (see at least Fig 1; 44, 46, 48, and 50), and transferring the picked media to the media dispense path (see at least Fig 1, Ref 54, 56)

Graef does not explicitly disclose wherein the media dispensing modules are removable, however Lynch discloses a self service terminal wherein the modules are removable (see at least Column 2, lines 59-62). It would have been obvious to anyone of ordinary skill in the art at the time of invention to include the teachings of Lynch to the disclosure of Graef so that said modules can be taken from the machine to either be refilled or taken to a remote location for deposit or reconciliation with records related to transactions at the machine. Moreover, Lynch discloses a currency cassette containing a stack of currency notes is removably mounted (see at least col. 2, ll. 60). It would be expected that the removable containers of Lynch would also be interchangeable since the containers are used for currency and currency has the same dimensions (i.e. \$10, \$20, etc.).

Drescher teaches at least one media module including at least one of the separate and removable media modules including a plurality of separate media containers (see at least Fig 1, Refs 100, 102, 104 and 106; Column 11, lines 41-52) and each media container having a lower face and a separate

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friction pick mechanism adjacent the media container's lower face (see at least Column 27, line 21 through col. 29, line 67 (Example of a dispense transaction)). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the terminal of Graef in view of Lynch to include separate containers with associated friction pick mechanisms as taught by Drescher. One of ordinary skill in the art at the time of the invention would have been motivated to expand the terminal of Graef in view of Lynch in this way since removable canisters allows for easier removal by authorized personnel (see at least col. 11, ll. 40-46 of Drescher) and since the picking operations are executed concurrently and multiple bills may be picked from the various storage locations and moved as a stream of separated noted (see at least col. 29, ll. 61-67 of Drescher).

Graef in view of Lynch et al and Drescher do not explicitly disclose each media container having a separate friction pick mechanism adjacent the media container's lower face, however, Drescher et al. discloses a plurality of storage locations (92, 94, 96, 98) which are further subdivided into smaller compartments, i.e. 96→100, 102, 104, 106. Drescher discloses a picking mechanism for each of the plurality of storage units 92, 94, 96, 98 (Fig. 1). Drescher further discloses selectively directing documents from the remote document segments into connection with adjacent canister delivery transports indicated as 124, 126, 128, 130 (see at least col. 11, 60-65). Moreover, Graef et al. disclose a individual canisters 44, 46, 48, 50, each associated with its own sheet dispensing mechanisms 34, 36, 38, 40, respectively, and each further with its own picking member 72 associated with a "face" of the canister (see at least col. 7, l. 25 through col. 8, l. 35). The differences of size change and/or substitution of material is obvious, and express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious. Making something separable, removable, smaller, larger, etc. involves only routine skill in the art and has no patentable significance unless a new and unexpected result is produced. Therefore, each media container having a separate friction pick mechanism adjacent the media container's lower face is at least a design choice.

Re Claim 12: Drescher discloses a media module for use in a self-service terminal, the media module comprising:

- Means defining a media dispense path (See at least Fig 1, and Column 27 line 21-Column 29, line 59)
- A plurality of separate media containers (see at least Fig 1, Refs 100, 102, 104 and 106: Column 11, lines 41-52)
- Each media container within the media module having a lower face and an each media container within the media module having a separate friction pick mechanism adjacent the media container's lower face for picking media from the media container (see at least Column 27, line 21 through col. 29, line 67 (Example of a dispense transaction)) and transferring the picked media to the media dispense path (see at least Column 29, lines

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10-20) for transporting media from the media dispensing module (see at least Column 29, lines 15-20)

Graef in view of Lynch et al and Drescher do not explicitly disclose each media container having a separate friction pick mechanism adjacent the media container's lower face, however, Drescher et al. discloses a plurality of storage locations (92, 94, 96, 98) which are further subdivided into smaller compartments, i.e. 96→100, 102, 104, 106. Drescher discloses a picking mechanism for each of the plurality of storage units 92, 94, 96, 98 (Fig. 1). Drescher further discloses selectively directing documents from the remote document segments into connection with adjacent canister delivery transports indicated as 124, 126, 128, 130 (*see at least* col. 11, 60-65). Moreover, Graef et al. disclose a individual canisters 44, 46, 48, 50, each associated with its own sheet dispensing mechanisms 34, 36, 38, 40, respectively, and each further with its own picking member 72 associated with a "face" of the canister (*see at least* col. 7, l. 25 through col. 8, l. 35). The differences of size change and/or substitution of material is obvious, and express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious. Making something separable, removable, smaller, larger, etc. involves only routine skill in the art and has no patentable significance unless a new and unexpected result is produced. Therefore, each media container having a separate friction pick mechanism adjacent the media container's lower face is at least a design choice.

Re Claim 14: Drescher discloses a method of dispensing media from a self-service terminal, the method comprising the steps of:

- Selectively removing media from one of a plurality of separate media containers disposed within a media module, each of the media containers within the media module having a lower face and each media container within the media module having a separate friction pick mechanism adjacent the media container's lower face for picking media from the media container and transferring the picked media to a media dispense path for removing the media from the media module (see at least Column 27, line 21 through col. 29, line 67 (Example of a dispense transaction))
- Presenting removed media to a user (see at least Column 30, lines 35-40)

Graef in view of Lynch et al and Drescher do not explicitly disclose each media container having a separate friction pick mechanism adjacent the media container's lower face, however, Drescher et al. discloses a plurality of storage locations (92, 94, 96, 98) which are further subdivided into smaller compartments, i.e. 96→100, 102, 104, 106. Drescher discloses a picking mechanism for each of the plurality of storage units 92, 94, 96, 98 (Fig. 1). Drescher further discloses selectively directing

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documents from the remote document segments into connection with adjacent canister delivery transports indicated as 124, 126, 128, 130 (*see at least* col. 11, 60-65). Moreover, Graef et al. disclose a individual canisters 44, 46, 48, 50, each associated with its own sheet dispensing mechanisms 34, 36, 38, 40, respectively, and each further with its own picking member 72 associated with a "face" of the canister (*see at least* col. 7, l. 25 through col. 8, l. 35). The differences of size change and/or substitution of material is obvious, and express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious. Making something separable, removable, smaller, larger, etc. involves only routine skill in the art and has no patentable significance unless a new and unexpected result is produced. Therefore, each media container having a separate friction pick mechanism adjacent the media container's lower face is at least a design choice.

Response to Arguments

Applicant's arguments filed 28 February 2008 have been fully considered but they are not persuasive for at least the following reasons:

- ❖ The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
- ❖ Examiner would like to point out that the Supreme Court in *KSR International Co. v. Teleflex Inc.* described seven rationales to support rejections under 35 U.S.C. 103:
 - Combining prior art elements according to known methods to yield predictable results;
 - Simple substitution of one known element for another to obtain predictable results;
 - Use of known technique to improve similar devices (methods, or products) in the same way;
 - Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
 - "Obvious to try" –choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
 - Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and

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- Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations; however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The "mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." see *Dann v. Johnson*, 425 U.S. 219, 230 (1976).

Separate/Removable:

- ❖ Applicant has amended the claims to recite "separate" media containers, and had previously amended the claims to recite removable media containers. Making something "separable" or "removable" involves only routine skill in the art and has not patentable significance unless a new and unexpected result is produced.
- ❖ Furthermore, Applicant noted Drescher shows separate storage areas within a canister, it is respectfully pointed out that Applicants specification however does not provide an explicit definitions for "media containers" and "media module". Furthermore, in paragraph [0004] of Applicants published application (US 20020198838), it is stated that a conventional ATM is usually provided with two, three or four media modules, or cassettes. Thus the separate storage areas within a canister as taught by Drescher do not function any differently than the "media containers" and "media module" recited by the claims. Moreover, Drescher discloses at col. 25, ll. 17-23 "the storage of documents is described with reference to Figs. 47-53 and that for purposes of illustration, storage of a document in storage area (102) as shown in Fig. 35...". Therefore, the Examiner maintains that Drescher teaches the claimed "media containers" and "media module".
- ❖ Moreover, during patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). Furthermore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the terms removable and separate are given their broadest reasonable interpretation since the specification does not provide an explicit definition.

Rearrangement of Parts:

- ❖ Claims 12 and 14 have been amended to recite "the media module having a lower face and a separate friction pick mechanism adjacent the media container's lower face for picking media from the media container". Drescher discloses a friction pick mechanism that is adjacent the media container

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so as to retrieve the media from the side/face where the media is collected from, see at least Figs. 55-58; col. 29, ll. 15-20 and col. 27 l. 21 through col. 29, line 59. Drescher also discloses "the picking operations are executed concurrently in the preferred embodiment of the invention. Multiple bill may be picked from various storage locations and moved as a stream of separated notes..." see at least col. 29, ll. 62-67. In view of the above, the Examiner maintains that Drescher discloses "the media module having a lower face and a separate friction pick mechanism adjacent the media container's lower face for picking media from the media container" since Drescher discloses concurrent/simultaneous operation of the picking operations from the storage units

- ❖ Moreover, during patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). Furthermore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the term "friction pick mechanism" is given its broadest reasonable interpretation since the specification does not provide an explicit definition.

Hindsight

- ❖ Applicants argue that the Office Action applies hindsight with respect to teaching a vacuum pick and a friction pick in the same self service machine. The Examiner respectfully disagrees for at least the following reasons. In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicants are respectfully pointed to col. 13, l. 64 through col. 14, l. 7 of Graef. In particular, Graef discloses that the Graef picking mechanism may be readily retrofit to an existing automated banking machine. Moreover, this allows for replacing an existing picking member which does not include the features of the Graef picking mechanism and install the Graef picking mechanism in the existing picking mechanism's place. Graef therefore, teaches two different types of picking mechanisms within one unit. Moreover, Sevak et al. discloses "a document feeder of an apertured friction feed belt and an apertured feed pulley for pickably feeding documents from a hopper into a document guideway, a vacuum chamber being stationarily disposed within the feed to apply a low pressure vacuum to a linear section", please refer to col. 2, ll. 40-51 of Sevak et al. Thus, Sevak et al. discloses a vacuum pick and friction pick with in the same unit.

Lower face Argument:

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Applicants argue that Drescher does not have a lower face adjacent an associated separate pick mechanism. The Examiner respectfully disagrees. The term lower is non-functional descriptive matter. Moreover, Drescher teaches a "face" that is adjacent an associated separate pick mechanism as addressed above. The way in which the machine is assembled is a mere design choice and involves only routine skill in the art and has no patentable significance unless a new and unexpected result is produced.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH M. MONFELDT whose telephone number is (571)270-1833. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm (EST) ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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